

## **REMARKS**

### **A. Status of the Application**

Claims 1-6 were originally filed in this application. Claims 3 and 5 have previously been cancelled. In the Final Office Action dated May 20, 2003, the Examiner rejected Claims 1, 4, and 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,294,548 to Watson ("Watson"); and Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Watson in view of U.S. Patent No. 5,492,401 to Halsted ("Halsted"). Thus, Claims 1, 2, 4, and 6 are at issue.

### **B. Rejection of Claims 1, 4 and 6 Over Watson**

The Examiner has rejected Claims 1, 4, and 6 under 35 U.S.C. § 103 as being obvious in view of Watson. Applicant respectfully disagrees and traverses the Examiner's rejection.

The law is clear that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)." The Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness. Specifically, claims 1, 4 and 6 each include the element, "a mounting plate abutting the motor and surrounding the motor output shaft." Applicant submits that Watson fails to disclose, teach or suggest this element.

At page 4 of the Official Action, the Examiner acknowledges that the structure in Watson upon which the Examiner relies may be a transmission casing. Nevertheless, the Examiner contends that this structure is a "mounting plate." The cited structure is neither labeled with a reference numeral nor described anywhere in the specification of Watson. Indeed, nothing in Watson supports the Examiner's contention that the cited structure is a mounting plate. Because the Examiner cannot point to any teaching in Watson or otherwise to suggest that the transmission casing of Watson should nonetheless be considered a "mounting plate" the rejection of Claims 1, 4 and 6 should under 35 U.S.C. §103(a) is inappropriate in view of the deficiency of the primary reference.

The Examiner also contends that Applicant "has not pointed out any difference between the

claimed plate and that of Watson.” (Office Action Mailed 5/20/03, P.4, Par. 4). Applicant respectfully submits that the Examiner, not the Applicant, has the burden of establishing a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). As discussed above, the Examiner has failed to meet this burden.

Assuming, *arguendo*, that the Examiner has made a *prima facie* case of obviousness, Applicant has more than effectively rebutted the Examiner’s case. The ultimate determination of patentability is based on the entire record with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Upon the record, it is more likely than not that the structure in Watson is not a mounting plate within the meaning of the present Claims. This is especially true, considering that the Examiner has pointed to nothing in Watson or otherwise to indicate the contrary. Thus, the prior art does not disclose or suggest every element of Claims 1, 4, and 6.

Moreover, there is no suggestion in the cited art to modify Watson to include “a mounting plate abutting the motor and surrounding the motor output shaft.” The law is clear that the cited reference must suggest the invention described by the claim, or the Examiner must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention obvious in light of the teachings of the cited reference in order to support a conclusion that a claim is directed to obvious subject matter. See *Ex Parte Clapp*, 227 U.S.P.Q. 972 (PTO Bd. App. 1985) (emphasis added). “[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et al.*, 871 F.2d 115, 10 U.S.P.Q.2d 1397, 1398, (Fed. Cir. 1989), citing, *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Unless the reference suggests the particular combination, it cannot show the actual invention was obvious. *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-1375, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993).

There is no motivation whatsoever to modify Watson to include a mounting plate abutting the motor and surrounding the motor output shaft. Indeed, Watson teaches away from such a modification. As discussed above, Watson describes that the motor (1) is “pivotally mounted on

brackets (5) on the framework on one side of the motor.” (*see* Watson at col. 2, lines 2-8). Watson further teaches the use of this pivotal mounting to provide the required tension on the driving belts, which transfer power from the motor to the drive shaft (3) to provide tension required for the driving belts. (*see* Watson at col. 2, lines 2-8). Accordingly, the use of a “mounting plate” in connection with the concrete mixer of Watson would make difficult, and possibly even prohibit, one’s ability to adjust the tension of the belts. Consequently, the use of such a mounting plate is contrary to the teachings of Watson. Thus, one of ordinary skill would have no motivation to modify Watson to include “a mounting plate abutting the motor and surrounding the motor output shaft” as claimed.

For this additional reason, Applicant respectfully submits that the § 103 rejection of claims 1, 4 and 6 over Watson has been obviated.

**C. Rejection of Claim 2 Over Watson in View of Halsted**

The Examiner has rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over the Watson in view of U.S. Patent No. 5,492,401 to Halsted. Applicants respectfully traverse this rejection.

Claim 2 also contains the limitation “a mounting plate abutting the motor and surrounding the motor output shaft,” as it depends from Claim 1. As discussed above, Watson does not disclose or suggest such a mounting plate. Similarly Halsted does not disclose or suggest such a mounting plate. Thus, Claim 2 is not obvious in view of Watson and Halsted because all the elements of the claim are not disclosed or suggested by the cited prior art.

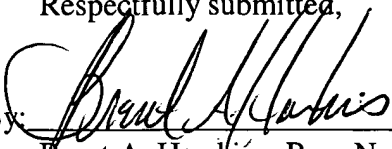
### CONCLUSION

In view of the above Remarks, Applicant respectfully submits that Claims 1, 2, 4, and 6 are patentable over the cited prior art, and are in condition for allowance. Applicant respectfully requests that the Examiner withdraw the rejections of Claims 1, 2, 4, and 6 and enter an allowance of the same. Applicant further invites the Examiner to contact the undersigned attorney to discuss any matters pertaining to the present Application.

Respectfully submitted,

Dated: November 19, 2003

By:

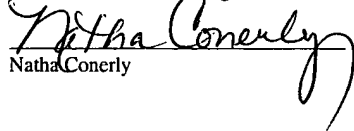
  
Brent A. Hawkins, Reg. No. 44,146  
Customer No. 26967  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53rd Floor  
Chicago, Illinois 60606-6630  
312.554.3300

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Natha Conerly